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Dated: July 2, 2009

Electronic Signature for Elizabeth A. Hanley: /Elizabeth A. Hanley/

Docket No.: 117750-04703
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Prasad Koteswara KAPA *et al.*

Application No.: 10/527,628

Confirmation No.: 9537

Filed: May 25, 2005

Art Unit: 1626

For: PROCESS FOR PREPARING
INTERMEDIATES

Examiner: Rodriguez-Garcia, Valerie

MS Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT UNDER 37 C.F.R. § 1.705(b)(2)

Dear Sirs:

1. This statement is respectfully submitted in support of the “Application for Patent Term Adjustment Under 37 C.F.R. § 1.705(b)” being filed herewith for the above-referenced patent application. In view of the following, it is respectfully requested that Applicants be granted a Patent Term Adjustment of 1,176 days.
2. Pursuant to 37 C.F.R. § 1.705(b)(2)(i), Applicants respectfully submit that the correct period of Patent Term Adjustment is 1,176 days which includes A-delays, B-delays and overlap between A-delays and B-delays. First, pursuant to 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1), Applicants are entitled to an adjustment of 787 days due to the U.S. Patent and Trademark Office’s (USPTO) failure to mail a notification or notice of allowance prior to 14 months after the date on which the Applicant fulfilled the requirements of 35 U.S.C. § 371 (A-delays). Pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.703(a)(6), Applicants are also entitled to an adjustment of at least 11 days due to the USPTO’s failure to issue the patent within 4 months of

payment of the issue fee (A-delays). Pursuant to 37 C.F.R. §§ 1.702(b)(1) and 1.703(b), Applicants are also entitled to an adjustment of 578 days due to the USPTO's failure to issue a patent within 3 years of the commencement of this application under 35 U.S.C. § 371(b) (B-delays). Pursuant to 35 U.S.C. § 154(b)(2)(A), the Patent Term Adjustment is reduced by 200 days due to overlap of A-delays and B-delays. Accordingly, pursuant to 37 C.F.R. § 1.703(f), Applicants are entitled to a Patent Term Adjustment of 1,176 days, which is equivalent to the sum of the A-delays and B-delays minus the overlap terms.

3. The relevant dates, pursuant to 37 C.F.R. § 1.705(b)(2)(iii), and the adjustment that the patent will be entitled to, pursuant to 37 C.F.R. § 1.703(f), are set forth as follows:

A-Delays: USPTO Examination Delays Pursuant to 37 C.F.R. § 1.702(a) and § 1.703(a)

In the instant application, Applicants note that the Notice of Allowance allotted 787 days of USPTO A-delays. Applicants respectfully submit that this calculation is in error. Applicants note that the 35 U.S.C. § 371 requirements were fulfilled on May 25, 2005. Pursuant to 37 C.F.R. § 1.703(a)(1) Applicants are entitled to a period of adjustment that is equivalent to the number of days beginning on the day after the date that is fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. § 371 and ending on the date of mailing of an action under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151. For purposes of C.F.R. § 1.703(a)(1), the 14-month date is July 25, 2006. Applicants note that the first notification, a Restriction Requirement, was mailed on September 19, 2008. Accordingly, the sum of the days in the period beginning on July 25, 2006 and ending on September 19, 2008 is 787 days of A-delay (hereinafter "the first set of A-delays"). However, there are additional A-delays.

Specifically, it is stated in the notice of allowance that the patent will be issued on October 13, 2009, which is the Tuesday that immediately precedes the date that is 28 weeks from the mailing date of the notice of allowance. Pursuant to 37 C.F.R. § 1.703(a)(6) applicants are entitled to an adjustment in patent term that is equivalent to the number of days in the period beginning on the day after the date that is four months after the date the issue fee was paid and all outstanding requirements were satisfied and ending on the date a patent was issued. In the present case, the issue fee will be paid no later than July 2, 2009. For purposes of 37 C.F.R. §

1.703(a)(6), the 4-month date is no later than October 2, 2009. The number of days in the period beginning on October 2, 2009 and ending on October 13, 2009 is 11 days (herein after “the second set of A-delays”).

Accordingly, the USPTO has accrued a summed total of 798 days of A-delay.

B-Delays: USPTO Three-Years Delay Pursuant to 37 C.F.R. § 1.702(b) and § 1.703(b)

In the instant case, the Patent Term Adjustment listed in the Notice of Allowance granted 0 days of B-delays. However, Applicants believe that this Patent Term Adjustment has been made in error. Applicants respectfully note that the national stage of the application commenced on March 14, 2005. The three-year period, for purposes of calculating B-delays, ended on March 14, 2008. Accordingly, pursuant to 37 C.F.R. § 1.703(b), Applicants are entitled to a Patent Term Adjustment that is equivalent to the sum of the number of days in the period beginning on March 14, 2008 and ending on the date that the patent issues. Applicants note that the Notice of Allowance states that the patent will be issued on the Tuesday immediately preceding the date that is 28 weeks from the mailing date of the Notice of Allowance. The Notice of Allowance was mailed on April 3, 2009. Accordingly, the patent will issue no earlier than Tuesday October 13, 2009. The sum of the period beginning on March 14, 2008 and ending on October 13, 2009 is 578 days.

Accordingly, the USPTO has accrued 578 days of B-delay.

Reduction of Patent Term Adjustment Pursuant to 37 C.F.R. § 1.704(a)

Applicants note that the notice of allowance attributed 0 days of reduction to the Applicants. Applicants do not dispute this reduction.

Exclusions From Patent Term Adjustment Pursuant to 37 C.F.R. § 1.703(b)(4)

Applicants note that the notice of allowance attributed 0 days of exclusions to the Applicants. Applicants do not dispute this exclusion.

Overlapping Periods of USPTO A-Delays and B-Delays Pursuant to 37 C.F.R. § 1.703(f)

As set forth in 37 C.F.R. §1.703(f), the period of adjustment based on the grounds set forth in 37 C.F.R. § 1.702 is the sum of all periods of Examination Delay and the maximum period of Three Years Delay, to the extent these periods of delay are not overlapping. Pursuant to 37 C.F.R. 1.703(f), the period of adjustment will not exceed the actual number of days the issuance of the patent was delayed. Applicants note that the U.S. District Court of D.C. has recently clarified that under 35 USC §154(b)(2)(A) the only way a period of Examination Delay (“A-delay”) and a period of Three-Years Delay (“B-delay”) can “overlap” is if they occur on the same calendar day or days. See Wyeth v. Dudas, No. 07- 1492. 2008 U.S. Dist. LEXIS 76063 at 9 (D. D.C. Sept. 30, 2008). In the instant case, the B-delays began on March 14, 2008 and will end on October 13, 2009. Between those two dates were 189 days of the first set of A-delays and all 11 days of the second set of A-delays. Accordingly, there were 200 days of overlap between A-delays and B-delays.

4. In accordance with 37 C.F.R. 1.705(b)(2)(iii), Applicants submit that the above-referenced application is not subject to a terminal disclaimer.
5. In view of 37 C.F.R. 1.705(b)(2)(iv)(A), Applicants submit that they are unaware of any circumstances during the prosecution of the application that would constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.
6. In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that the issued patent reflect a Patent Term Adjustment of 1,176 days.
7. In accordance with 37 C.F.R. 1.705(b)(2)(i), Applicants submit herewith the fee set forth in 37 C.F.R. 1.18(e). It is Applicants’ understanding that this \$200.00 fee is required for this

application for Patent Term Adjustment. However, should any additional fees be necessary, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-4876, under Order No. 117750-04703.

Dated: July 2, 2009

Respectfully submitted,

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